

PATENT COOPERATION TREATY

DEC 11 2004

From the INTERNATIONAL SEARCHING AUTHORITY

PCT

NOTIFICATION OF TRANSMITTAL OF THE INTERNATIONAL SEARCH REPORT AND THE WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY, OR THE DECLARATION

(PCT Rule 44.1)

To:
BRIAN HICKMAN
HICKMAN PALERMO TRUONG & BECKER LLP
1600 WILLOW STREET
SAN JOSE, CA 95125

Date of mailing
(day/month/year)

Applicant's or agent's file reference
60097-0241

FOR FURTHER ACTION See paragraphs 1 and 4 below

International application No.
PCT/US04/00561

International filing date
(day/month/year, 08 January 2004 (08.01.2004)

Applicant
TIVO INC.

1. ☒ The applicant is hereby notified that the international search report and the written opinion of the International Searching Authority have been established and are transmitted herewith.

Filing of amendments and statement under Article 19:
 The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):

When? The time limit for filing such amendments is normally two months from the date of transmittal of the international search report.

Where? Directly to the International Bureau of WIPO, 34 chemin des Colombettes
 1211 Geneva 20, Switzerland, Facsimile No.: +41 22 740 14 35

For more detailed instructions, see the notes on the accompanying sheet.
2. ☐ The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect and the written opinion of the International Searching Authority are transmitted herewith.
3. ☐ With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:
 - ☐ the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.
 - ☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.
4. **Reminders**
 Shortly after the expiration of **18 months** from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90bis.1 and 90bis.3, respectively, before the completion of the technical preparations for international publication.

 The applicant may submit comments on an informal basis on the written opinion of the International Searching Authority to the International Bureau. The International Bureau will send a copy of such comments to all designated Offices unless an international preliminary examination report has been or is to be established. These comments would also be made available to the public but not before the expiration of 30 months from the priority date.

 Within **19 months** from the priority date, but only in respect of some designated Offices, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase **until 30 months** from the priority date (in some Offices even later); otherwise, the applicant must, **within 20 months** from the priority date, perform the prescribed acts for entry into the national phase before those designated Offices.

 In respect of other designated Offices, the time limit of **30 months** (or later) will apply even if no demand is filed within 19 months.

 See the Annex to Form PCT/IB/301 and, for details about the applicable time limits, Office by Office, see the *PCT Applicant's Guide*, Volume II, National Chapters and the WIPO Internet site.

Name and mailing address of the ISA/ US
Mail Stop PCT, Attn: ISA/US
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Facsimile No. (703) 305-3230

Authorized officer

KENNETH A. WIEDER

Telephone No. 703 305-7608

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

To:
BRIAN HICKMAN
HICKMAN PALERMO TRUONG & BECKER LLP
1600 WILLOW STREET
SAN JOSE, CA 95125

PCT

NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL SEARCH REPORT AND
THE WRITTEN OPINION OF THE INTERNATIONAL
SEARCHING AUTHORITY, OR THE DECLARATION

(PCT Rule 44.1)

Applicant's or agent's file reference 60097-0241	Date of mailing (day/month/year) 08 DEC 2004
International application No. PCT/US04/00561	FOR FURTHER ACTION See paragraphs 1 and 4 below
Applicant TIVO INC.	International filing date (day/month/year) 08 January 2004 (08.01.2004)

1. ☒ The applicant is hereby notified that the international search report and the written opinion of the International Searching Authority have been established and are transmitted herewith.
- Filing of amendments and statement under Article 19:**
The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):
- When?** The time limit for filing such amendments is normally two months from the date of transmittal of the international search report.
- Where?** Directly to the International Bureau of WIPO, 34 chemin des Colombettes
1211 Geneva 20, Switzerland, Facsimile No.: +41 22 740 14 35
- For more detailed instructions, see the notes on the accompanying sheet.**
2. ☐ The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect and the written opinion of the International Searching Authority are transmitted herewith.
3. ☐ With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:
- ☐ the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.
- ☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.
4. **Reminders**
- Shortly after the expiration of **18 months** from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90bis.1 and 90bis.3, respectively, before the completion of the technical preparations for international publication.
- The applicant may submit comments on an informal basis on the written opinion of the International Searching Authority to the International Bureau. The International Bureau will send a copy of such comments to all designated Offices unless an international preliminary examination report has been or is to be established. These comments would also be made available to the public but not before the expiration of 30 months from the priority date.
- Within **19 months** from the priority date, but only in respect of some designated Offices, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase **until 30 months** from the priority date (in some Offices even later); otherwise, the applicant must, **within 20 months** from the priority date, perform the prescribed acts for entry into the national phase before those designated Offices.
- In respect of other designated Offices, the time limit of **30 months** (or later) will apply even if no demand is filed within 19 months.
- See the Annex to Form PCT/IB/301 and, for details about the applicable time limits, Office by Office, see the *PCT Applicant's Guide*, Volume II, National Chapters and the WIPO Internet site.

Name and mailing address of the ISA/ US
Mail Stop PCT, Attn: ISA/US
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Facsimile No. (703) 305-3230

Authorized officer

KENNETH A. WIEDER

Telephone No. 703 305-7608

PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference 60097-0241	FOR FURTHER ACTION <small>see Form PCT/ISA/220 as well as, where applicable, item 5 below.</small>	
International application No. PCT/US04/00561	International filing date (<i>day/month/year</i>) 08 January 2004 (08.01.2004)	(Earliest) Priority Date (<i>day/month/year</i>) 08 January 2003 (08.01.2003)
Applicant TIVO INC.		

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 2 sheets.



It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the Report

- a. With regard to the **language**, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐

The international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).

- b. ☐ With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, see Box No. I.

2. ☐ **Certain claims were found unsearchable** (See Box No. II)

3. ☐ **Unity of invention is lacking** (See Box No. III)

4. With regard to the **title**,

☒

the text is approved as submitted by the applicant.

☐

the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,

☒

the text is approved as submitted by the applicant.

☐

the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box No. IV. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. With regard to the **drawings**,

- a. the figure of the **drawings** to be published with the abstract is Figure No. 1

☒

as suggested by the applicant.

☐

as selected by this Authority, because the applicant failed to suggest a figure.

☐

as selected by this Authority, because this figure better characterizes the invention.

- b. ☐ none of the figures is to be published with the abstract.

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US04/00561

A. CLASSIFICATION OF SUBJECT MATTER

IPC(7) : H04N 5/76; H04N 7/173

US CL : 386/83; 348/10, 12, 13; 358/335; 360/33.1

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

U.S. : 386/83; 348/10, 12, 13; 358/335; 360/33.1

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X -- Y	US 5805763 A (LAWLER et al) 08 September 1998, see Figs. 1-2, col. 3, lines 28-44 and col. 5, lines 45-48	1-5,11,13-15,17-21,27 and 29-31 ----- 6,7,10,12,22,23,26 and 28
X	US 6675388 B1 (BECKMANN et al), 06 January 2004, see col. 4, lines 10-14	1,3,8,17,19, and 24
Y	US 6374406 B2 (HIRATA), 16 April 2002, see abstract col. 1, lines 49-62	6,10,22 and 26
X -- Y	US 6209132 B1 (HARRISON et al), 27 March 2001, col. 8, lines 4-11	6,9,10,16,22,25,26 and 32 ----- 4,9,12,25 and 28
A	US 6412112 B1 (BARRETT et al), 25 June 2002, see entire document	
A	US 6288716 B1 (HUMPLEMAN et al), 11 September 2001, see entire document	



Further documents are listed in the continuation of Box C.



See patent family annex.

* Special categories of cited documents:	
"A" document defining the general state of the art which is not considered to be of particular relevance	"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
"E" earlier application or patent published on or after the international filing date	"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)	"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
"O" document referring to an oral disclosure, use, exhibition or other means	"&" document member of the same patent family
"P" document published prior to the international filing date but later than the priority date claimed	

Date of the actual completion of the international search

02 November 2004 (02.11.2004)

Name and mailing address of the ISA/US

Mail Stop PCT, Attn: ISA/US
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Facsimile No. (703) 305-3230

Date of mailing of the international search report

08 DEC 2004

Authorized officer

WAYNE BOST

Telephone No. 703 305-7608

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

To:
BRIAN HICKMAN
HICKMAN PALERMO TRUONG & BECKER LLP
1600 WILLOW STREET
SAN JOSE, CA 95125

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Date of mailing (day/month/year) 08 DEC 2004	
FOR FURTHER ACTION See paragraph 2 below	
Applicant's or agent's file reference 60097-0241	
International application No. PCT/US04/00561	International filing date (day/month/year) 08 January 2004 (08.01.2004)
Priority date (day/month/year) 08 January 2003 (08.01.2003)	
International Patent Classification (IPC) or both national classification and IPC IPC(7): H04N 5/76; H04N 7/173 and US Cl.: 725/131,134,140, 142, 151, 153	
Applicant TIVO INC.	

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/ US Mail Stop PCT, Attn: ISA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (703) 305-3230	Authorized officer KENNETH A. WIEDER Telephone No. 703 305-7608
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Form PCT/ISA/237 (cover sheet) (January 2004)

ENTRY
DATABASE

DOCKETED

DATE:

12/14/04 k

Art 34 Amend 2 Due 1/8/05

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/US04/00561

Box No. 1 Basis of this opinion

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

- ☐ This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

- ☐ a sequence listing
☐ table(s) related to the sequence listing

b. format of material

- ☐ in written format
☐ in computer readable form

c. time of filing/furnishing

- ☐ contained in international application as filed.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US04/00561

Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims <u>6,7,9,10,22,23,25,26 and 28</u>	YES
	Claims <u>1-5,8,11,13-21,24,27 and 29-32</u>	NO
Inventive step (IS)	Claims <u>NONE</u>	YES
	Claims <u>1-32</u>	NO
Industrial applicability (IA)	Claims <u>1-32</u>	YES
	Claims <u>NONE</u>	NO

2. Citations and explanations:

Please See Continuation Sheet

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US04/00561

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

V. 2. Citations and Explanations:

Claim 1-5, 11, 13-15, 17-21, and 27 lack novelty under PCT Article 33(2) as being anticipated by Lawler et al.

As to claim 1, Lawler et al reference which discloses a process for remotely controlling storage and the operations of a client system. The claimed "providing a plurality of client systems" is met by multiple viewer stations 16, which include an interactive station controller 18 and recording device 23 among other things (see fig. 1-2, col. 3, lines 28-44 and col. 5, lines 45-48). The claimed "authoring a capture a capture request" and "sending said capturing request from a server to a client systems" is met by setting a record tag, sending it to the head end 12, monitoring the record tag and, at appropriate time, controlling the associated program by informing the interactive station controller, which then controls the recording device 23 to record the associated program (col. 3, lines 15-21 and col. 13, lines 7-18 and 20-22).

As to claim 2, the claimed said "capture request instructs said client systems the time and channel to schedule said recording of specific content" is met by the record tag as describe above (see col. 3, lines 15-21, lines 7-18 and 20-22) being based off of a program name, time and channel (col. 7, lines 10-18 and 44-58).

As to claim 3, the claimed "said specific content is video or data content broadcast across said television broadcast signal" is met by television programs provided by the head end 12, which may included various types of video signals, computer-executed applications, or other types of programming (see col. 3, lines 61-67).

As to claim 4, the claimed "said capture request request specifies said specific content using the program name and optionally an Affiliate name" is met by the record tag described above (above col. 3, lines 15-21 and col. 13, lines 7-18 and 20-22) being based off of a program name, and/or other attributes such as time, channel (col. 7, lines 10-18 and 44-58) or even an Affiliate name.

As to claim 5, the claimed "said capture request schedules single recordings or schedules recording of all the showings of a series" is met by record tags associated associated with single recordings or a particular showing of a program, as well as record tags associated with successive episodes of a daily or weekly series of programs (see col. 12, line 29- col. 13, line 7).

As to claim 11, the claimed "said capture request instructs said client system to create a season pass for program series, and wherein a season pass records every showing of a program on a specified channel" is met by the successive episodes recording for daily or weekly program series as describe above in claim 5.

As to claim 13, the claimed "said server modifies a capture request that said client system has previously received" is met by a situation where a program already has a record tag set at the client or user system, and the user may remove the record tag, which would affect the user information that is transmitted to the head end and would further affect the server at the head end by causing the capture request the client system had previously received to be modified and removed (see col. 4, lines 11-23).

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US04/00561

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

As to claim 14, the claimed "said server targets specific client systems to receive a particular capture request" is met by the service and application servers 30 of Lawler et al containing a subscriber database which may contain subscriber or client specific information including each user's identity, viewing preferences and history, and other information, which may be used to target specific users or clients to receive a specific capture or recording request (see col. 4, lines 11-23).

As to claim 15, the claimed "said capture request specifies content to be transferred from said client system to a device connected to said client system" is met by the record tags as previously described above in claim 1, in addition to the head end which may send signals to the interactive controller to program the recording device which is connected to the interactive controller of the client system in order to control recording of programs sent from the headend to the interactive client device (see col. 6, lines 44-56).

As to claims 17-21, 27 and 29-31, the claimed apparatus is met by a similarity or correspondence to the rejection of the method claims 1-5, 11 and 13-15, as described above for the Lawler et al reference respectively.

Claim 1, 3, 8, 17, 19 and 24 lack inventive step under PCT Article 33(3) as being obvious over Beckmann et al.

As to claim 8, the claimed "said capture request sets recording tuner priority level when said client system has multiple input tuners" is met by the STB 16 in fig. 3, where one tuner 18 is dedicated to the video channel while another tuner 19 is dedicated to the data channel (col. 4, lines 61-65), whereby if the information is sent via the video channel, it has the priority of using the first tuner 18 by manufacturers design or default.

As to claim 17, 19 and 24, the claimed apparatus is met by similarity or correspondence to the rejection of method claims 1, 3, and 8, as described above for the Beckmann et al reference respectively.

Claim 16 and 32 novelty under PCT Article 33(2) as being anticipated by Harrison et al.

As to claim 16, note the Harrison et al reference which discloses a process for remotely controlling storage allocations of a client system. The claimed "providing a plurality of client systems" is met by the systems present at each consumer's location 34 (see fig. 3 & 4 and col. 6, lines 20-22 and 49-51). The claimed "authoring an operational request" is met by the broadcaster determining which data to purge on the consumer's system (col. 8, lines 7-9). The claimed "sending said operation request from a server to a client system", and "said operational request is received by a client system" is met by the broadcaster setting the criteria for determining which data to purge by assigning an expiration date and/or a priority to associated data files that are transmitted to the consumers and received by the consumers systems (col. 7, line 20-col. 8, line 11).

As to claim 32, the claimed apparatus is met by a similarity or correspondence to the rejection of method claim 16, as described above.

Claims 6, 10, 22 and 26 lacks an inventive step under PCT Article 33(3) as being obvious over Lawler et al, in view of Hirata.

As to claim 6 and 10, the Lawler et al reference does not explicitly disclose the claimed "said capture request sets attributes of said recorded specific content." However, the Hirata reference also teaches a process for remotely controlling storage and the operation of a client system, where an electronic mail a control command or message may be transmitted through a public line, received by a modem section of a gateway, converted to digital data, and supplied to a control section, where a CPU of the control section extracts the control command.

As to claim 22 and 26, the claimed apparatus is met by a similarity or correspondence to the rejection of the method claims 6 and 10, as described above.

Claims 7 and 23 lacks an inventive step under PCT Article 33(3) as being obvious over Lawler et al.

As to claim 7, the Lawler et al reference does not explicitly disclose the claimed "said capture request sets the location of said recorded specific content on said client system's device; wherein said location is either user storage space or system storage space." However, the Examiner takes Official Notice that it is notoriously well known in the art of client/server systems where the server is

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US04/00561

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

sending content to the client for storage to specify the location of the storage for the advantages of not overwriting previously recorded, and to keep track of what content is stored on the client and where or at what location the content is provide successful retrieval of the content when needed.

As to claim 23, the claimed apparatus is met by a similarity or correspondence to the rejection of the method.

Claims 9 and 25 lacks an inventive step under PCT Article 33(3) as being obvious over Hirata in view of Harrison et al.
As to claim 9, the Lawler and Hirata references do not explicitly disclose the claimed "said capture request specifies a suggested minimum length of time that a recording should remain on the client system's storage device". The Harrison et al references teaches the uses of an expiration date and/or priority that is assigned to data files on a local data manager 84 purges older and less used information through the use of an expiration date and/or priority associated with the data files.

As to claim 25, the claimed apparatus is met by a similarity or correspondence to the rejection of the method claim 9, as described above.

Claims 12, and 28 lacks an inventive step under PCT Article 33(3) as being obvious over Lawler et al in view of Harrison et al.

As to claim 12, Lawler et al reference does not explicitly disclose the claimed "said capture request specifies an expiration date for itself". The Harrison et al reference discloses the teaching of expiration dates as describe above in claim 9.

As to claim 28, the claimed apparatus is met by a similarity or correspondence to the rejection of the method claim 12, as describe above.

NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the *PCT Applicant's Guide*, a publication of WIPO.

In these Notes, "Article," "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

What parts of the international application may be amended ?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Preliminary Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

When ? Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

Where not to file the amendments ?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

How ? Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

The amendments must be made in the language in which the international application is to be published.

What documents must/may accompany the amendments ?

Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.

NOTES TO FORM PCT/ISA/220 (continued)

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

The following examples illustrate the manner in which amendments must be explained in the accompanying letter:

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added." or
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

"Statement under Article 19(1)" (Rule 46.4)

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)).

The statement will be published with the international application and the amended claims.

It must be in the language in which the international application is to be published.

It must be brief, not exceeding 500 words if in English or if translated into English.

It should not be confused with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It may not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

Consequence if a demand for international preliminary examination has already been filed

If, at the time of filing any amendments and any accompanying statement, under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the time of filing the amendments (and any statement) with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments (and of any statement) and, where required, a translation of such amendments for the procedure before that Authority (see Rules 55.3(a) and 62.2, first sentence). For further information, see the Notes to the demand form (PCT/IPEA/401).

Consequence with regard to translation of the international application for entry into the national phase

The applicant's attention is drawn to the fact that, upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see the *PCT Applicant's Guide*, Volume II.